IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	
	:	
Carol L. Colrain et al.	:	Confirmation Number: 8991
	:	
Serial No.: 10/086,782	:	Group Art Unit: 2168
	:	
Filed: February 28, 2002	:	Examiner: Harold E. Dodds

For: SYSTEM AND METHOD FOR PROVIDING COOPERATIVE RESOURCE GROUPS FOR HIGH AVAILABILITY APPLICATIONS

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF

Sir:

This is in response to the Final Office Action mailed May 8, 2006, the shortened statutory period for which runs until August 8, 2006.

THE OFFICE ACTIONS FAIL TO PRESENT A PRIMA FACIE CASE OF OBVIOUSNESS UNDER 35 U.S.C. § 103(a) AS A MATTER OF LAW

35 U.S.C. § 103(a) states:

> "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the **subject matter sought to be patented** and the prior art are such that the subject matter **as a whole** would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains" (emphasis added).

Thus, as a matter of law, to present a prima facie case of obviousness under 35 U.S.C. § 103(a), the differences between the subject matter sought to be patented and the prior art must be such that the **subject matter sought to be patented as a whole** would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

The Patent Office has long recognized that a proper rejection based on 35 U.S.C. § 103(a) must allege that the subject matter sought to be patented as a whole must be disclosed or taught by the prior art. MPEP § 2106, II, C states:

> [W]hen evaluating the scope of a claim, **every** limitation in the claim must be considered. Office personnel may not dissect a claimed invention into discrete elements and then evaluate the elements **in isolation**. Instead, the claims as a whole must be considered. (emphasis in original)

Thus, to establish a prima facie case of obviousness as a matter of law, the claimed limitations, as a whole, must be alleged to be taught or suggested by the prior art. Merely dissecting a claimed invention into discrete elements, and then evaluating the dissected elements in isolation fails to present a prime facie case of obviousness as a matter of law.

In violation of MPEP § 2106, II, C and 35 U.S.C. § 103(a), the Office Actions not only divide each claim into its constituent elements, but also finely dissects each constituent element into a set of short phrases and sentence fragments. The Office Actions then point out how each individual fragment corresponds to a similar fragment in any one of a handful of references. The fragment-to-prior-art correlation appears to have been made without any consideration as to the relationship between the fragments, the meaning of the elements as a whole, and the meaning of the claim as a whole.

None of the cited references have been cited to disclose, teach, or suggest the subject matter of any element of any of the independent claims. Instead, the Office Actions dissect the claimed elements into discrete elements and then evaluates the dissected elements in isolation, rather than considering the elements as a whole. For example, no cited reference is alleged to show the subject matter of "in response to said first node becoming unavailable, automatically configuring a second node of the cluster to respond to requests associated with said IP address." Instead:

- One portion of Gamanche is cited to show "in response to said first node becoming unavailable",
- another portion of Gamanche is cited to show "automatically configuring a second node of the cluster",
- Armentrout is cited to show "to respond to requests", and
- yet another portion Gamanche is cited to show "associated with said IP address."

As stated in MPEP § 2106, II, C, **Office personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation.** It is respectfully submitted that, rather than alleging that the subject matter of "in response to said first node becoming unavailable, automatically configuring a second node of the cluster to respond to requests associated with said IP address" is taught by any cited reference, the Office Actions impermissibly dissect the claimed invention into discrete elements and then evaluates those elements in isolation.

Accordingly, it is submitted that the Office Actions fails to present a prima facie case of obviousness under 35 U.S.C. § 103(a) as a matter of law. As a consequence, it is respectfully submitted that the rejection made to Claims 43-60 under 35 U.S.C. § 103(a) may not be properly maintained. Therefore, Applicants respectfully request either (a) an explanation as to why the **subject matter sought to be patented as a whole** in each of each of Claims 43-60 is obvious in view of the prior art, or (b) allowance of each of Claims 43-60 where an explanation as to why the **subject matter sought to be patented as a whole** is obvious in view of the prior art cannot be provided.

CONCLUSION

The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

At any time during the pendency of this application, please charge any fee shortages or credit any overages to Deposit Account No. 50-1302.

Respectfully submitted,

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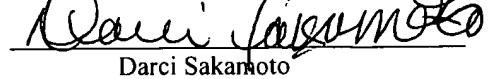
On July 7, 2006 By 
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